

REMARKS

Claims 1-27 were present in the application and stand rejected. By the foregoing amendment, independent Claims 1 and 24 have been amended, dependent Claims 5-8 and 10-14 have been amended to change claim dependency, and Claims 4, 9, 15-23 and 25-27 have been canceled from the application. It is believed that applicants' remaining claims are in condition for allowance in view of the foregoing amendments and following comments.

This application is a continuation of applicants' parent Application No. 08/948,887 (now U.S. Patent No. 6,153,618). In the parent application, the Examiner indicated that claims generally of the scope of the claims originally set forth in this application were allowable, but suspended prosecution of the parent application due to a potential interference. The Examiner further drew applicants' attention to Example 53 of WO 97/16452, and indicated that applicants may wish to consider cancellation of the $R_1 = \text{aryl}$ choice in Claim 1 of the parent application. In accordance with the Examiner's suggestion, applicants cancelled $R_1 = \text{aryl}$ from the parent application, which then proceeded to issue.

As amended, the claims of the present application are now directed to those compounds of Formula 1 where $R_1 = \text{aryl}$, the subject matter that was deleted from the parent application.

Double Patenting

The Examiner has rejected original Claims 1-27 under the judicially created doctrine of obviousness-type double patenting over Claims 1-26 of applicants' parent case, now U.S. Patent No. 6,153,618. Upon resolution of the other patentability issues in this case, it is applicants' current intention to file a terminal disclaimer to overcome this ground for rejection.

Rejection of Claims Under 35 U.S.C. § 112

The Examiner rejected Claim 9 under 35 U.S.C. § 112, first and second paragraphs. This claim has been canceled from the present application.

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Original Claims 1-27 have been rejected under 35 U.S.C. § 112, second paragraph, as being indefinite. In this regard, the Examiner has indicated that the scope of "esters" is unclear. By the foregoing amendments, this term has been deleted from independent Claims 1 and 24.

The Examiner has further indicated that the term "alkyl" has been rendered indefinite by the description at page 3 of the application, which covers cyclic terms such as cyclohexyl. In this regard, the specification has been amended in a manner corresponding to amendments made in the parent application (now U.S. Patent No. 6,153,618) to eliminate this issue.

The Examiner has rejected Claim 26 under 35 U.S.C. § 112, second paragraph, as being indefinite and has rejected Claims 25-27 under 35 U.S.C. § 112, first paragraph, as lacking enablement. These claims have been canceled from the present application, without prejudice to applicants' right to pursue the subject matter of these claims in a separate application.

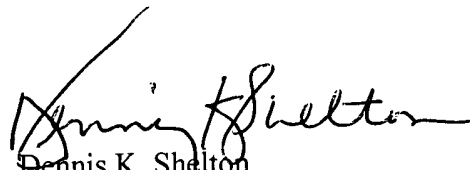
In view of the foregoing, it is believed that the Examiner's rejections of claims under 35 U.S.C. § 112 are now moot.

CONCLUSION

This application is believed to be in condition for allowance. Reconsideration and favorable action is requested.

Respectfully submitted,

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I hereby certify that this AMENDMENT is being deposited with the U.S. Postal Service in a sealed envelope as first class mail with postage thereon fully prepaid and addressed to the Commissioner for Patents, Washington, D.C. 20231, on the below date.

Date:

11/7/01

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VERSION WITH MARKINGS TO SHOW CHANGES MADE NOVEMBER 7, 2001

In the Specification:

The paragraph beginning at page 3, line 16, has been amended as follows:

The term "alkyl" as used herein refers to saturated hydrocarbon radicals containing from 1 to 12 carbon atoms, inclusive. Alkyl radicals may be straight[, or branched[, or cyclic]. Exemplary alkyl radicals include n-pentyl, n-hexyl, n-octyl, n-dodecyl, 2-dodecyl, 3,5-diethylcyclohexyl, duryl, and the like. The term "lower alkyl" as used herein refers to straight[, or branched[, and cyclic] chain hydrocarbon radicals having from 1 to 8 carbon atoms, such as methyl, ethyl, propyl, isopropyl, n-butyl, s-butyl, t-butyl, n-pentyl, n-hexyl, [cyclopentyl, cyclohexyl, 2-methylcyclopentyl,] and the like. "Alkoxy" refers to radicals of the formula -OR, where R is alkyl as defined above: "lower alkoxy" refers to alkoxy radicals wherein R is lower alkyl. "Hydroxy-lower alkyl" refers to radicals of the formula HO-R-, where R is lower alkylene of 1 to 8 carbons, and may be straight, branched, or cyclic. "Hydroxy-lower alkoxy" refers to radicals of the formula HO-R-O-, where R is lower alkylene of 1 to 8 carbons, and may be straight, branched, or cyclic. "Lower alkoxy-lower alkyl" refers to groups of the formula R_aO-R_b- , where R_a and R_b are each independently lower alkyl.

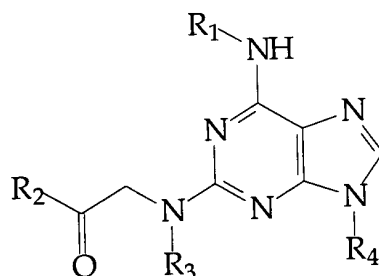
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The paragraph beginning at page 4, line 14, has been amended as follows:

The term "cycloalkyl" refers to alkyl radicals of 3-20 carbon atoms having at least one ring of carbon atoms, such as cyclopropyl, cyclobutyl, cyclopentyl, cyclohexyl, 2-methylcyclopentyl, and the like. "Bicycloalkyl" refers to alkyl radicals of 7-20 carbon atoms having at least two fused rings of carbon atoms (in which one or more carbon atoms are members of both rings). "Tricycloalkyl" refers to alkyl radicals of 7-20 carbon atoms having at least three fused rings of carbon atoms (in which one or more carbon atoms of each ring are simultaneously members of another ring).

In the Claims:

1. (Amended) A compound of formula 1:



wherein:

R₁ is [alkyl, cycloalkyl,] aryl, [aralkyl, heteroaryl, or heteroaralkyl,] substituted with 0-3 substituents selected from lower alkyl, halo, hydroxy, lower alkoxy, amino, lower alkyl-amino, and nitro;

R₂ is hydroxy, amino, or lower alkoxy;

R₃ is H, lower alkyl, lower acyl, lower alkoxy-acyl, or amino-acyl;

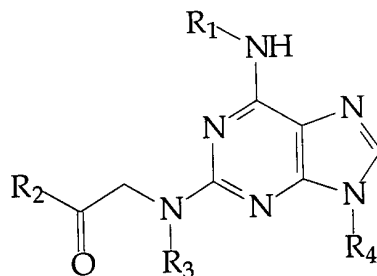
R₄ is H or lower alkyl;

and pharmaceutically acceptable salts [and esters] thereof.

5. (Amended) The compound of claim [4] 3, wherein R₃ is propanoyl.

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6. (Amended) The compound of claim [4] 3, wherein R₃ is 3-methylbutanoyl.
7. (Amended) The compound of claim [4] 3, wherein R₃ is butanoyl.
8. (Amended) The compound of claim [4] 3, wherein R₃ is H.
10. (Amended) The compound of claim [9] 3, wherein R₃ is methoxyacetyl.
11. (Amended) The compound of claim [9] 3, wherein R₃ is H.
12. (Amended) The compound of claim [9] 3, wherein R₃ is aminoacetyl.
13. (Amended) The compound of claim [9] 3, wherein R₃ is propanoyl.
14. (Amended) The compound of claim [9] 3, wherein R₃ is 3-methylbutanoyl.
24. (Amended) A pharmaceutical composition, comprising:
a compound of the formula 1:



wherein

R₁ is [alkyl, cycloalkyl,] aryl, [aralkyl, heteroaryl, or heteroaralkyl,] substituted with 0-3 substituents selected from lower alkyl, halo, hydroxy, lower alkoxy, amino, lower alkyl-amino, and nitro;

R₂ is hydroxy, amino, or lower alkoxy;

R₃ is H, lower alkyl, lower acyl, lower alkoxy-acyl, or amino-acyl;

R₄ is H or lower alkyl;

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or a pharmaceutically acceptable [salts and esters] salt thereof; and a pharmaceutically acceptable excipient.

Claims 4, 9, 15-23, and 25-27 have been canceled.

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